

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-17 and 24-65 are pending. Without prejudice or disclaimer, claims 1, 24-26, 53, 57, and 59 are amended herein, and new claims 60-65 are added. Support for these amendments and new claims can be found in original claims 1, 18-23, 24-26, 53, 57, and 59, and in the specification as-filed at page 10. Accordingly, Applicants submit that the above amendments raise no issue of new matter.

II. ARGUMENTS

The Examiner rejects claims 1-17 and 24-59 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Pub. No. 2002/0046431 to Laurent et al. ("Laurent") in view of U.S. Patent Application Pub. No. 2001/0023514 to Cottard et al. ("Cottard") for the reasons disclosed at pages 2-3 of the Office Action.

According to the Examiner, Laurent "suggests the use of oleyl alcohol . . . and thickeners in a hair dyeing formulation." Office Action at 2 (citing Laurent at page 21, paragraph 0466, and page 22, paragraph 0493). The Examiner relies on Cottard for disclosing a "dyeing composition comprising synthetic thickeners . . . and at least one fatty alcohol including lauryl (12 carbons) alcohol and oleyl (18 carbons) alcohol." Office Action at 3 (citing Cottard at page 3, paragraph 0049, and page 17, paragraph 0347). Thus, the Examiner contends that it would have been obvious to one having ordinary skill in the art to incorporate the synthetic thickeners as taught by Cottard in the dyeing composition of Laurent and to replace the oleyl alcohol in the composition of Laurent with the lauryl alcohol taught by Cottard. *Id.*

Applicants respectfully traverse this rejection because the Examiner has failed to establish, as required by M.P.E.P. § 2143, a prima facie showing of obviousness. Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467.

Thus, in order to carry the initial burden of establishing a prima facie case of obviousness that satisfies the *Graham* standard, the Examiner must at least show that the prior art reference must teach or suggest all the claim limitations, and that there is some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. See M.P.E.P. § 2143. The Supreme Court, in the recent *KSR* case, recognized that a showing of “teaching, suggestion, or motivation” could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, slip op. at 14.

In addition, the Supreme Court mandates that “[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) (“[R]ejections on obviousness grounds cannot

be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Following the *KSR* decision, the USPTO issued a memorandum to its technology center directors on May 3, 2007, indicating that **“in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”** (Emphasis in original).

The Examiner has not established a *prima facie* case of obviousness for several reasons. First, the Examiner asserts that “there is a clear suggestion and sufficient motivation to one having ordinary skill in the art to be motivated to incorporate the synthetic thickeners as taught by Cottard et al. in the dyeing composition of Laurent et al. to arrive at the claimed invention.” Office Action at 3. However, the literal combination of the thickener of Cottard with the composition of Laurent would not result in the presently claimed invention. The Examiner does not appreciate the fact that Laurent makes reference to a specific set of thickeners, specifically “thickeners containing sugar units,” and does not discuss whether one of ordinary skill in the art would deem the thickeners of Laurent and the thickeners of Cottard as equivalent. Further, the Examiner overlooks that Laurent teaches fatty alcohols outside of the claimed range. The Examiner simply concludes that it would have been obvious to substitute two separate components of Laurent with those taught by Cottard

(specifically, a fatty alcohol and a thickener). It is unclear why it would have been obvious to substitute both components, rather than one or the other.

Finally, to further support their position, Applicants submit herewith the Rule 1.132 Declaration of Isabelle SCHLOSSER, executed on June 11, 2007.

By its very nature, an obviousness rejection is based on the assumption that similar compositions will exhibit similar properties. However, as shown by the experimental results contained in the SCHLOSSER Declaration, this is not the case for the present obviousness rejection. In the SCHLOSSER Declaration, a comparison was made between two oxidation dye compositions, Inventive Composition A and Comparative Composition B, differing only with respect to the length of the fatty alcohol used. See SCHLOSSER Declaration at ¶ 7.

Applicants found that the Comparative Composition B exhibited significantly inferior properties. Specifically, the Inventive Composition A exhibited an unexpectedly superior viscosity after mixing with the oxidizing agent, as well as superior coloration, as compared to Comparative Composition B. See SCHLOSSER Declaration at ¶¶ 11, 16-20. Since the only difference was the fatty alcohol, these results are directly attributed to the claimed combination.

In addition to the SCHLOSSER Declaration, Applicants point to the specification as-filed for further support. The specification as-filed also provides an example which comparing a composition of the invention, comprising at least one polyoxyalkylenated C10-C14 fatty alcohol, and a comparative composition comprising at least one longer chained polyoxyalkylenated fatty alcohol.

The results from the comparative example in the specification as-filed, similar to the results provided in the SCHLOSSER Declaration, show the comparative composition exhibits inferior properties. Specifically, the inventive composition exhibited a superior shade. See Specification as-filed at page 48. Since the only difference was the fatty alcohol, these results are directly attributed to the claimed combination.

In addition to all of the deficiencies of the Examiner's rejection discussed above, the references relied on by the Examiner do not suggest the improved properties of the claimed invention. Thus, Applicants submit that the experimental results further demonstrate the nonobviousness of the presently claimed invention over the prior art, which does not remotely suggest such properties. See SCHLOSSER Declaration at ¶¶ 18 and 20.

For at least the foregoing reasons, the Examiner has failed to establish a prima facie case of obviousness. As the Examiner has failed to satisfy his burden under 35 U.S.C. § 103, with respect to the combination of references, *i.e.*, Laurent and Cottard, Applicants respectfully submit that this combination is improper. Accordingly, Applicants respectfully request withdrawal of all § 103 rejections.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

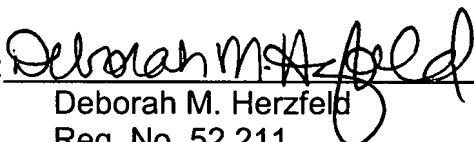
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully urged to contact Applicants' undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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